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REMARKS

Claims 1-27 are pending in the present application. In the Office Action mailed May 4, 2004, the Examiner rejected claims 1, 11, 18, and 22 based on double patenting. The Examiner next rejected claim 1-3, 6, 8-11, 13-15, 17-19, and 21-27 under 35 U.S.C. §102(b) as being anticipated by Rive (USP 6,301,666). Claims 4, 7, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rive. Claims 5-7, and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rive in view of Mi et al. (USP 6,523,067). Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rive in view of Lahtinen (WO 99/25086).

Before addressing the substantive rejections, two typographical errors identified upon reviewing the present Application in preparation for the present Response have been corrected. Specifically, paragraph 31 consists of two separate paragraphs that were inadvertently combined. Please provide the proper indentation as illustrated above. Additionally, Applicant identified that a sentence within paragraph 31 stated "Of the status..." but should read "If the status...." Accordingly, please amend the Specification as indicated above.

Statutory-type Double Patenting

The Examiner rejected claims 1, 11, 18, and 22 as conflicting with "all of the independent claims of Application No. 09/681,480; 09/681,481; and 09/681,483. The Examiner stated that this "conflict is tantamount to statutory type double patenting based on 35 U.S.C. §101." The Examiner's double patenting rejection of claims 1, 11, 18, and 22 is improper for two reasons: (1) the proffered double patenting type rejection must be, at most, provisional and (2) it is not "statutory" double patenting.

First, since the current invention is co-pending with the 09/681,480; 09/681,481; and 09/681,483 applications, any such rejection must be provisional. See MPEP §706.02(k) and 804. That is, since none of the cited applications have issued, under MPEP §706.02(k), the rejection must be provisional. *Id.*

Second, the Examiner asserted that the "conflict" with all of the independent claims of the above-referenced co-pending applications gives rise to "statutory-type" double patenting. To sustain such a rejection claims 1, 11, 18, and 22 of the present application and all of the independent claims of the above-referenced applications must call for the "same invention." See MPEP §804(II)(a). When comparing the claims of separate applications to determine a case of statutory type double patenting, the claims must be "identical" to the point that only variations

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within the claim elements that are meaningless within the test for literal infringement, can be tolerated. See MPEP §804(II)(a).

When comparing claims 1, 11, 18, and 22 of the present application with the above-cited co-pending applications, it is apparent that the “same invention” is not being claimed. The claims are not identical as explicitly required to sustain a statutory-type double patenting rejection. As such, since the claims are not “identical,” the “same invention” is not being claimed, under the test for double patenting under 35 U.S.C. §101, as articulated within MPEP §804(II)(a), this statutory-type double patenting rejection is not sustainable.

Claim Rejections Under Section 102(b)

The Examiner rejected claim 1 as unpatentable over Rive. However, the rejection is not sustainable because Rive simply does not teach each and every element of the claim. Specifically, neither the sections cited by the Examiner, nor Rive, as a whole teaches that which is called for in claim 1.

For example, claim 1 expressly calls for “generating an activation key configured to permit indefinite use of the option in response to an indefinite use grant,” “transmitting the activation key,” and “automatically enabling user access to the option resident on the device in response to the reception of the activation key.” With respect to these claim elements, the Examiner cited Col. 15, lns. 40–47 and Col. 17, lns. 38–55. However, as will be shown, neither the sections cited by the Examiner, nor Rive as a whole, teaches that which is called for in the claim.

Specifically, Rive teaches that in response to an activation request, the “support service” utilizes a password that “enables the support service to bypass the restrictions placed on edits to the registry 40 and to disable the restrictions on the registry 40.” Col. 15, lns. 45–49. Therefore, Rive teaches that a password is used only to unlock the previously locked registry of the local computer. Therefore, while the local computer includes the inactive application, the password does not serve to actually activate the inactive application, as claimed. This is in direct contrast to claim 1, which calls for “automatically enabling user access to the option resident on the device in response to reception of the activation key.” One of ordinary skill will readily recognize that unlocking a previously restricted registry does not include “automatically enabling user access to the option resident on the device in response to reception of the activation key.”

In fact, Rive expressly reiterates this fact by requiring that once the registry is active (i.e. unlocked by the password), a subsequent and independent step must be taken to actually activate the inactive application. Specifically, Rive teaches that “[h]aving access to the registry 40, the

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support service may then modify settings to make the desired application available, readily executable, and easily launched in a conventional manner on the computer system 50.” Col. 15, lns. 49–53. Rive further defines the step of actually activating the inactive application by stating that “the ‘activation’ of the desired application involves the (1) restoration of launch icons to the desktop and/or appropriate menus presented by the operating system 62 and (2) the designation of the application as ‘allowed application’ within the registry 40.” Col. 15, lns. 53–57. (Enumeration added).

Therefore, Rive does not teach “automatically enabling user access to the option resident on the device in response to reception of the activation key,” as called for in claim 1. Rather, Rive teaches that the transmission of the password and the activation are two separate and distinct steps. First, the support service must utilize a password to unlock the registry of the computer system, which was previously protected from being edited. Col. 15, lns. 45–49. Then, only after the registry has been unlocked using the password, Rive teaches the additional and independent step of actually activating the application, which consists of multiple substeps. Therefore, Rive teaches that enabling user access is neither automatic nor responsive to the reception of the activation key.

Furthermore, Rive does not teach or suggest “generating an activation key configured to permit indefinite use of the option in response to an indefinite use grant,” as called for in claim 1. (Emphasis added). Simply, Rive fails to teach the generation of an activation key in response to such a request. Rather, at best, Rive simply teaches the use of a preexisting password in response to a request. That is, Applicant agrees that an activation key may be tantamount to a password but Rive does not teach that a password is “generated in response to an indefinite use grant,” as called for in claim 1. To the contrary, at best, Rive suggests that the password is generated well prior to the receipt and/or grant of any use request. That is, Rive expressly teaches that the original configurer of the computer set access restrictions to the registry and/or the policy file when initially configuring the computer. See Col. 12, lns. 22–24. As such, Rive teaches and suggests that any password that may be used to unlock the registry is generated at the time of the original locking of the registry, which corresponds to the original configuring of the computer system prior to the end user’s receipt of the computer. Therefore, from the explicit teachings of Rive, one of ordinary skill in the art will readily recognize that password generation must occur well prior to the user ever receiving the computer system or having access to the computer system to make the requisite use request. See Col. 12, lns. 22–24 and Figs. 8–9. Accordingly, Rive fails

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to teach or suggest a system or method for later generating a password or activation key "in response to an indefinite use grant," as called for in claim 1.

Additionally, Applicant has amended claim 1 to further clarify the invention. Specifically, claim 1 has been amended to clarify that the device requesting enablement of the option is a "medical device." One of ordinary skill in the art will readily recognize that medical devices are very different from other consumer-type devices, such as the personal computers taught by Rive. That is, many medical devices are subject to additional rules and regulations not present with other consumer-type devices. For example, the purchase and use of many medical devices carry additional prerequisites such as of proper educational requirements, certifications, or geographical location. On the other hand, the purchase or use of devices such as personal computers do not typically carry such prerequisites.

To further clarify this point, Applicant has amended claim 1 to clarify that the "set of criteria" used to determine whether to grant indefinite use of an option "includes whether the customer is qualified to use the medical device." Additionally, claim 1 calls for continuous monitoring this qualification to determine whether such remains satisfied.

Rive, which is concerned only with consumer-type purchases of personal computers and associated software, does not teach determining whether the customer is qualified nor does it teach continuously monitoring any set of criteria after the option has been enabled to determine whether such remains satisfied. Again, as Rive is directed to personal computers and not medical devices, Rive is not concerned with whether a customer is qualified to use the requested option. As such, while Rive teaches that a requesting computer is identified to determine whether the desired software is already installed and that a user identifier is used to retrieve contract and/or compensation arrangements, Rive does not teach or suggest that the user be "qualified" to use the option. See col. 1, ln. 55 to col. 2, ln. 16, col. 15, lns. 3-5, and col. 16, lns. 60-67. Furthermore, Rive does not teach or suggest that any monitoring continue following the enablement of the option. To the contrary, Rive teaches that once payment is secured, the "support service" enables the desired option or bills the user for the option in accordance with a subscription scheme. See col. 16, lns. 60-67 and col. 17, lns. 7-26.

For at least these reasons, claim 1 is patentably distinct from the art of record. Accordingly, claims 2-10 are also in condition for allowance pursuant to the chain of dependency. Nevertheless, Applicant believes claims 2-10 include additional subject matter that is patentably distinct from the art of record. As such, Applicant will highlight some of the numerous distinctions found in the dependent claims.

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For example, with respect to claim 3, the Examiner asserted that "Rive discloses the method of claim 2 wherein the activation key is self executing to automatically enable the option and further comprises the step of writing the alphanumeric code to memory of the device." As previously shown, Rive does disclose a password, which may be alphanumeric and may be stored within the memory of the device. However, as clearly shown with respect to claim 1, the password is merely utilized to unlock the registry and does not "self execute" and certainly does not "automatically enable the option." As such, the Examiner's assertion regarding claim 3 is incorrect and inconsistent with the teachings of Rive. Therefore, claim 3 is patentably distinct from the art of record.

With respect to claim 9, the Examiner asserted that "Rive discloses the method of claim 8 wherein an unqualified customer status includes ... incomplete educational requirements." The Examiner cited column 17, lines 7-26 in support. However, the cited section is focused on an evaluation of whether or not the user desiring access to an inactive option or application has made sufficient compensation arrangements with the support service. Nowhere does Rive teach or suggest that "educational requirements" are a factor for evaluation of whether the active option or application should be enabled. In fact, such an evaluation is inconsistent with the teachings of Rive. Specifically, Rive is expressly directed to a system and method to be utilized in conjunction with the ordering of a computer system from a supplier or manufacturer by a user, such as for individual use or business concerns. See Col. 1, lns. 21-22. To this end, it is well recognized that simple consumer purchases of personal computers do not have prerequisite "educational requirements" that computer manufacturers, distributors, or resellers evaluate prior to transacting a sale of a computer system. It appears the Examiner has overlooked this element of the claims. As Rive does not teach or suggest that which is expressly called for, claim 9 is patentably distinct from the art of record.

Accordingly, for at least the above reasons, Applicant believes that claims 3 and 9 are patentably distinct beyond the chain of dependency.

With respect to claim 11, the Examiner asserted that "the claim limitation is a system claim that is substantially similar to method claim 1" and is "rejected based on the similar rationale." Applicant does not agree, however, and incorporates herein the relevant remarks with respect to claim 1. Additionally, Applicant has amended the claim to clarify the invention. That is, Applicant has amended the claim to further clarify that enabling recurrent use of the at least one inactive software application is "directly responsive to receipt of the access code."

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As previously shown with respect to claim 1, Rive fails to teach that which is claimed. Rather, at best, Rive teaches that any "access code" is used only to unlock the previously restricted registry and that actual enablement of any "inactive software" requires additional steps, i.e. "the 'activation' of the desired application involves the restoration of launch icons to the desktop and/or appropriate menus presented by the operating system 62 and designation of the application as an 'allowed application' within the registry 40." Col. 15, lns. 45-57. Therefore, Rive does not teach or suggest that "directly responsive to receipt of the access code," the system "enable[s] recurrent use of the at least one inactivated software application resident on the device," as called for in claim 11.

For at least these reasons, Applicant believes claim 11 is patentably distinct from the art of record. Accordingly, claims 12-17 are in condition for allowance pursuant to the chain of dependency.

With respect to claim 18, the Examiner asserted that "the claim limitation is a computer program claim that is substantially similar to method claim 1." As such, the Examiner rejected claim 18 "based on the similar rationale." While, the relevant remarks with respect to claim 1 are hereby incorporated, claim 18 is independent and requires review independent from claim 1.

In an effort to further clarify the invention, Applicant has amended claim 18. Specifically, Applicant has amended the claim to further clarify that the computer program causes the computer to perform a multi-tiered validation/qualification check that is not only not taught or suggested by Rive but is inconsistent with the retail sale of personal computer to which Rive is directed. Claim 18 calls for receipt and validation of (1) a user identifier and (2) a system identifier and then, only after receipt and validation of by the user and system identifier, (3) a determination of user qualification. Accordingly, only after all three criteria have been met, is the computer caused to "generate an electronic enabler", as shown in Fig. 2.

On the other hand, Rive does not teach or suggest this multi-tiered and thorough validation/qualification system. Rather, Rive teaches that the only qualification to having an option enabled is compensation. See col. 16, lns. 60-67 and col. 17, lns. 7-26. While Rive teaches the use of a system identifier and an option identifier to discern whether the desired option is currently installed on the system, Rive does not consider any user identifier or the qualifications of user.

Therefore, for at least these reasons, claim 18 is patentably distinct from the art of record. As such, claims 19-21 are in condition for allowance pursuant to the chain of dependency.

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With respect to claim 22 the Examiner asserted that the limitations were substantially similar to claim 1. As such, the Examiner rejected claim 22 under "similar rationale" as claim 1. Again, as the basis of rejection with respect to claim 1 was previously shown to be unsustainable and the claim patentably distinct, Applicant hereby incorporates relevant remarks with respect to claim 1 herein. Additionally, claim 22 is an independent claim. Applicant has also amended claim 22 to clarify the invention. Specifically, Applicant has amended the claim to clarify that the device is a medical imaging device and that a determination is made as to whether the medical imaging devices "is capable of supporting the option requested."

As shown above, Rive does not teach or suggest medical devices and certainly does not teach or suggest medical imaging devices. Rather, Rive is specifically directed to personal computers and associated software. Nevertheless, Rive does not teach or suggest any determination of whether a given personal computer is capable of supporting the option requested. As stated above, Rive simply teaches enabling the option if the user has a valid compensation agreement. See col. 60-67. At best, Rive teaches only a determination of whether the retailer, not the personal computer, supports the option and is preinstalled. See col. 15, lns. 3-14 and 58-65. Therefore, Rive does not teach or suggest determining "whether the medical device is capable of supporting the option requested."

Accordingly, Applicant believes claim 22 is patentably distinct from the art of record. Furthermore, claims 23-27 are in condition for allowance pursuant to the chain of dependency.

Claim Rejections Under Section 103(a)

The Examiner rejected claims 5-6 as unpatentable over Rive in view of Mi et al. In proffering the rejection the Examiner stated that "validating user and determining which pre-installed application and means of request, i.e., mail, fax ..., are inherent." (Emphasis added). The Examiner must provide rational or evidence tending to show the asserted inherency. See MPEP §2112. Furthermore, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Therefore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). It therefore follows that the Examiner must provide objective evidence or cogent technical reasoning to support the conclusion of inherency or the rejection

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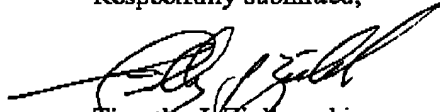
cannot be sustained. However, the Examiner did not provide either. As such, without the requisite evidence and reasoning the rejection of claims 5 and 6 cannot be maintained.

Finally, Applicant has added new claim 28, which is dependent upon claim 1. No new matter has been added.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-28.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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